

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed March 23, 2006 (“Office Action”). At the time of the Office Action, Claims 1-19 were pending in the application. In the Office Action, the Examiner rejects Claims 1-19. Applicant amends Claims 6 and 19. Applicant respectfully requests reconsideration and allowance of all pending claims.

**Statement Concerning Common Ownership**

The invention in this Application and U.S. Patent No. 6,773,169 B2 issued to Ebeling, et al. were, at the time the invention of this Application was made, owned by, or subject to an obligation of assignment to, Infineon Technologies AG.

**Section 103 Rejections**

The Examiner rejects Claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,773,169 B2 issued to Ebeling, et al. (“*Ebeling*”). Applicant respectfully traverses the Examiner’s rejection.

At the outset, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. 103. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).” (MPEP 2141.02). “Distilling the invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).” (MPEP 2141.02). The Examiner impermissibly ignores the subject matter of Claim 1 “as a whole” by distilling the invention down to a “gist” and arguing that “[t]he gist of the claimed invention is clearly taught by Ebeling et al reference.” (Office Action, p. 4). Moreover, the Examiner acknowledges that “Ebeling et al fails to teach explicitly the method for coupling the optoelectronic component to an end face of an optical fiber, as claimed.” (Office Action, p. 4). Applicant agrees that

*Ebeling* fails to teach the elements of Claims 1-19. For example, *Ebeling* completely fails to teach, suggest, or disclose, “arranging the fiber at a holding point a predetermined distance from the end face in such a way that the end face can perform a pivoting movement about the holding point” and “bringing the end face of the fiber and the component close to one another in the context of a coarse adjustment in such a way that a fine adjustment is subsequently effected between the component and the fiber in the context of an automatic self-centering by pivoting the fiber about the holding point” as recited in Claim 1. Rather than examine these claim elements, however, the Examiner simply provides the conclusory statement that “*Ebeling et al* is the evidence that ordinary skill in the art would find a reason, suggestion or motivation to have the method for coupling the optoelectronic component to an end face of an optical fiber as claimed in the instant application.” There is simply no basis in *Ebeling* to make this conclusory statement, and this conclusory statement in no way comprises a well-reasoned rejection of Claim 1 based on *Ebeling*. The Examiner has failed to examine the elements of Claim 1, as required. Consequently, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. In addition, the Examiner does not even provide a reasoned rejection of all the dependent claims.

In addition to the substantive reasons set forth above, Applicant respectfully requests reconsideration of this rejection because *Ebeling* is disqualified as prior art. Prior art may be disqualified under 35 U.S.C. § 103(c) if “the subject matter which would otherwise be prior art to the claimed invention and the claimed invention [are] commonly owned at the time the claimed invention was made.” M.P.E.P. § 706.02. The “Statement Concerning Common Ownership,” above, suffices as evidence to disqualify *Ebeling* as prior art for this Application. See M.P.E.P. § 706.02(l)(1). Applicant does not admit that *Ebeling* would otherwise qualify as valid prior art. In light of 35 U.S.C. § 103(c), *Ebeling* is disqualified as prior art and, consequently, Applicant respectfully requests reconsideration and allowance of Claims 1-19.

**CONCLUSION**

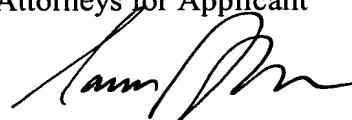
Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicant, at the Examiner's convenience at (214) 953-6581.

Applicant has attached hereto a separate Information Disclosure Statement along with a check in the amount of \$180.00. Applicant believes no other fees are due, however, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicant



Samir A. Bhavsar  
Reg. No. 41,617

Date: June 2, 2006

**CORRESPONDENCE ADDRESS:**

at Customer No.

**05073**